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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/474,317 | 12/29/1999 | GREGG HOMER | 12961 | 2106 |

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EXAMINER

MIRZA, ADNAN M

ART UNIT PAPER NUMBER

2152

DATE MAILED: 09/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/474,317

Applicant(s)

HOMER, GREGG

Examiner

Adnan M Mirza

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1-26 rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (U.S. 6,205,432) and in view of Eggleston et al (U.S. 6,101,531).

As per claim 1,7,10,20,22 Gabbard disclosed a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet; examining file headers in said packets to determine the presence of specific identifying indicia therein (col. 12, lines 2-30); and.

However Gabbard failed to disclose recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia. In the same field of endeavor Eggleston disclosed recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia (col. 8, lines 22-63).

It would have been obvious to one ordinary skill in the art at the time that invention was made to have incorporated recording the Internet Protocol header source address for each of the packets containing said specific identifying indicia as taught by Eggleston in the method of Gabbard to make the method more secure and reduce latency in processing the packets.

Art Unit: 2152

3. As per claim 2 Eggleston disclosed including the additional step of recording the Internet Protocol header destination address for the file (col. 8, lines 22-63).

4. As per claim 3,4 Eggleston disclosed including the additional step of transmitting said identifying indicia and said source Internet address to a proprietor of the file (col. 12, lines 43-67).

5. As per claim 5,8,21 Gabbard disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of an email message; searching each of said packets (col. 11, lines 45-67), in which port numbers indicative of email messages were found, for an attachment; and when said attachment is found, locating the source Internet address in an IP header for the file containing the attachment (col. 12, lines 1-32).

6. As per claim 6,9,13,26 Gabbard disclosed wherein said identifying indicia comprises a user defined character sequence selected from the group consisting of: an extension to an existing file format, prepended to the file; a sequence of bits embedded in the file; and an absence of code in a predefined area within the file (col. 16, lines 24-42).

7. As per claim 11, this claim differ from the claim 1 in that recording step, e.g. claim 1 recites "recording the Internet Protocol header source address" and claim 11 recites the same thing with different wording therefore, it is rejected accordingly.

8. As per claim 12 Gabbard disclosed wherein said examining step further includes: searching said file headers for TCP headers containing port numbers indicative of email messages (col. 11, lines 17-32); searching each of said packets, in which port numbers indicative of email messages were found, for a MIME header indicative of an attachment (col. 12, lines 1-

Art Unit: 2152

7); and when said MIME header indicative of an attachment is found: searching a header directly prepended to the file to find said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; and locating the source Internet address in an IP header for the file containing the attachment, when said identifying indicia is found (col. 12, lines 7-67).

9. As per claim 14 Eggleston disclosed a method for tracking the transmission of a digital file over the Internet comprising the steps of: placing identifying indicia in said digital file; using a data communications monitoring device to capture packets of information being transmitted via the Internet (col. 12, lines 39-46); examining certain ones of said packets to determine the presence of said identifying indicia in said file (col. 12, lines 47-57); and recording the source and destination Internet addresses for each of the packets containing said identifying indicia, and the identity of the file associated therewith (col. 8, lines 22-63).

10. As per claim 15 Eggleston disclosed wherein said identifying indicia is prepended to said header (col. 10, lines 34- 40).

11. As per claim 16 Gabbard disclosed wherein said identifying indicia is embedded in said file (col. 12, lines 3-32).

12. As per claim 17 Gabbard disclosed a method for tracking the transmission of a digital file over the Internet comprising the steps of: receiving packets constituting segments of the file in transit over the Internet; searching said packets for TCP headers containing port numbers indicative of email messages (col. 11, lines 17-32); searching each of said packets, in which said port numbers indicative of email messages were found, for a MIME header indicative of an attachment; and when said MIME header indicative of an attachment is found (col. 12, lines 1-

Art Unit: 2152

7): searching a header directly prepended to the file to locate said identifying indicia therein, when said MIME header is indicative of an attachment containing a type of said file sought; locating the source Internet address in an IP header for the file containing the attachment containing the type of said file sought, when said identifying indicia is located; and recording, for each of the packets containing said identifying indicia, the source Internet address for the file (col. 8, lines 22-63).

13. As per claim 18,19 Eggleston disclosed including the additional step of transferring said identifying indicia and said source Internet address to a proprietor of the file (col. 8, lines 22-63).

14. As per claim 23 Eggleston disclosed wherein said identifying indicia is located in a header having a field indicating that the frame size thereof is zero bytes in length (col. 8, lines 45-50).

15. As per claim 24,25 Eggleston disclosed wherein said identifying indicia is located in a header having a frame size field indicating that there is no information field appended to the frame size field (col. 10, lines 34-40).

Conclusion

16. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Adnan Mirza whose telephone number is (703)-305-4633.

17. The examiner can normally be reached on Monday to Friday during normal business hours.

Art Unit: 2152

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703)-305-4815. The fax for this group is (703)-746-7239.

18. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)-746-7239 (For Status Inquiries, Informal or Draft Communications, please label "PROPOSED" or "DRAFT");

(703)-746-7239 (For Official Communications Intended for entry, please mark "EXPEDITED PROCEDURE"),

(703)-746-7238 (For After Final Communications).

19. Any Inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-305-3900.

Any response to a final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks Washington, D.C.20231

Or faxed to:

Hand-delivered responses should be brought to 4th Floor Receptionist, Crystal Park II,
2021 Crystal Drive, Arlington, VA 22202.

Application/Control Number: 09/474,317
Art Unit: 2152

Page 7

AM

Adnan Mirza

Examiner

Art Unit 2152

MEHMET B. GECKIL
PRIMARY EXAMINER

Mehmet B. Geckil